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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,419

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Randal A. McCoy

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8084

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12/17/2004

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EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/608,419

Applicant(s)

MCCOY ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7-10, 12, 13, 15-19 and 21 is/are rejected.
- 7) ☒ Claim(s) 3, 5, 6, 11, 14, 20 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt is acknowledged of the Amendment filed September 27, 2004.

### ***Drawings***

2. The drawings were received on September 27, 2004. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 9, 10, 13, 15, 16, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Katis (US 6,601,761).

Re claims 1, 10 and 15, Katis discloses a method and system for a payment service provider to direct a payment to a payee on behalf of a payor having a credit card issued by a credit card issuer (Abstract and Fig. 1) comprising:

receiving, by the service provider (financial institution), a request for the service provider to direct a payment to a payee (merchant) on behalf of the payor (consumer 2);

transmitting payment information (col. 2, ll. 28-32; col. 2, ll. 52-57) associated with the received payment request from the service provider to the credit card issuer via other than a credit card network (Internet), the payment information including information identifying at least

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a payment amount (col. 5, ll. 55-64) and information identifying an account number associated with the payor credit card;

receiving, by the service provider and via other than a credit card network (Internet), funds from the credit card issuer responsive to the transmitted payment information (payment); and

directing, by the service provider, of delivery of funds in the identified payment amount and associated and remittance advice to the payee to complete the payment on behalf of the payor (col. 8, line 9-col. 9, line 47).

Re claims 2 and 16, Katis discloses the method as recited in rejected claims 1 and 15 stated above, further includes information identifying the payee (one of the merchants participating the co-branding electronic payment system).

Re claim 4, Katis discloses the method as recited in rejected claim 1 stated above, wherein the funds are delivered to the payee by one of a paper instrument and an electronic funds transfer; and

if the funds are delivered by electronic funds transfer, the funds are delivered via an electronic funds transfer network to a deposit account associated with the payee maintained at a financial institution (Figs. 2 and 4).

Re claim 9, Katis discloses the method as recited in rejected claim 1 stated above, wherein the funds are delivered to the payee at one of a time prior to, concurrent with, or subsequent to receipt of the funds from the credit card issuer (col. 3, line 21-col. 4, line 4).

Re claims 13, 19 and 21, Katis discloses the method as recited in rejected claims 1 and 15 stated above, wherein the payee does not accept credit card as a form of payment (a credit may be performed through a paper process such as check issued by a credit card company).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 8, 12, 17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katis (US 6,601,761) in view of Kramer et al. (US 6,327,574).

Re claim 7, 8, 12, 17 and 18, Katis discloses an on-line transaction using an electronic payment system.

However, the disclosure is silent about a credit card statement, the credit card being accepted by more than one payee, and the payor being associated with a consumer service provider.

Kramer discloses a pictorial example of an example structured document, here a credit card statement 200 (Fig. 2), and the types of information that may be usefully extracted during interpretation in order to update a consumer profile. The statement includes information identifying the a plurality of payees and other information about each transaction and the service/goods provider. The information may be used to build a unique consumer profile for each consumer for building more customized and personalized marketing strategy. It is also well

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known that the Automated Clearing House (ACH) network regulates the transferring of money including credit card transactions.

In view of Kramer teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a credit card statement with the payee information among other transaction data in addition to the credit card payment method as taught by Katis due to the fact that more targeted marketing can be achieved for the purpose of maximizing convenience of a consumer and profitability of a card issuer.

***Allowable Subject Matter***

7. Claims 3, 5, 6, 11, 14, 20, and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior arts of the record discloses, teaches or fairly suggests the claimed system and method comprising the step of issuing a credit card statement identifying the funds received by the service provider from the credit card issuer as a payment to the payee and not the service provider.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. The amended recitation necessitates an updated prior art search, which results in applying a newly found art to the amended claims as discussed above.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven S. Paik  
Primary Examiner  
Art Unit 2876

ssp